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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,772

03/06/2007

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RAN208T1

6846

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03/31/2009

EXAMINER

O'NEILL, BRIANNE E

ART UNIT

PAPER NUMBER

4177

MAIL DATE

DELIVERY MODE

03/31/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,772	<b>Applicant(s)</b> MAILLE, PIERRE	
	<b>Examiner</b> BRIANNE E. O'NEILL	<b>Art Unit</b> 4177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/30/2007 and 12/17/2007</u> .                               | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 4/30/2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 12/17/2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the US Document number listed does not exist with the document name given. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the orifices in the

Art Unit: 4177

housing must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 7 is objected to because of the following informality: The claim reads "a device according to 1 claim..." The claim should read "...according to claim 1..."  
Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 5-6, 8, 10 and 11 are rejected under 35 U.S.C. 102(e) as being unpatentable by Sieling et al. (US Patent # 6,960,039).**

In regards to claim 1, Sieling et al. teaches the claimed invention where a device comprising a housing (Figure 1a, 117, housing) provided with a marker face (Figure 1a, 121, nib port) and a plurality of makeup elements (Figure 1a, 103, nibs) permanently secured in said housing (Col 2, Lines 3-5) and projecting from said marker face, the housing acting as a handle (Col 1, Lines 22-25), the device being characterized in that the marker ends of said makeup elements are coplanar (see fig 1a). With regard to the limitation “makeup”, such limitation is an intended use language; Applicant is noted that all the claimed structures have been shown, the shown device is capable to be used as a makeup device such as marking on the skin, therefore, it meets the claimed language.

Art Unit: 4177

In regards to claim 2, as applied to claim 1 above, Sieling et al. teaches the device that includes a protective cap (Figure 1b, 105, cap) that comes into contact with said marker face.

In regards to claim 5, as applied to claim 1 above, Sieling et al. teaches the device characterized in that said housing is asymmetrical (see fig 1a).

In regards to claim 6, as applied to claim 1 above, Sieling et al. teaches the device characterized in that said makeup elements are juxtaposed in a plane (Figure 1b, 103, nibs).

In regards to claim 8, as applied to claim 1 above, Sieling et al. teaches the device characterized in that at least one of said makeup elements is an ink-impregnated wick (Col 3, Lines 16-17 and 19-22).

In regards to claims 10 and 11, as applied to claim 1 above, Sieling et al. discloses the makeup elements being attached in the housing as discussed in claim 1, with regard to the "made by being injected" or "injected around" limitations, applicant is noted that such features are directed to a method of making a device, such as an intermediate process, and since the final product of the instant invention is the same as the shown device, the intermediate process is not given patentable weight in an article claim.

**Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being unpatentable by Dutcher (US Patent # 6,033,139).**

Art Unit: 4177

In regards to claim 1, Dutcher teaches a device comprising a housing (Figure 1, 4, casing) provided with a marker face (Figure 1, 11, markers) and a plurality of makeup elements (Figure 1, 12, tip end) permanently secured (Col 2, Line 54-55 and 45) in said housing and projecting from said marker face, the housing acting as a handle (Col 1, Lines 46-48), the device being characterized in that the marker ends of said makeup elements are coplanar (see fig 1). With regard to the limitation "makeup", such limitation is an intended use language; Applicant is noted that all the claimed structures have been shown, the shown device is capable to be used as a makeup device such as marking on the skin, therefore it meets the claimed language.

In regards to claim 7, as applied to claim 1 above, Dutcher teaches at least one of said makeup elements is a makeup pencil (Col 1, Lines 8-11). With respect to the pencil being a makeup pencil, the device of Dutcher is capable for being used for makeup.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Sieling et al.**

In regards to claim 9, as applied to claim 1 above, Sieling et al. teaches the makeup elements are bonded in suitable orifices in said housing (Col 2, Lines 51-55), however does not teach the elements to be bonded with adhesive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive to bond the drawing instruments to the housing in order to keep the instruments secure.

**Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sieling et al., as applied to claim 1 above, and in view of Manougian et al. (US Patent # 7,047,983).**

In regards to claims 3 and 4, as applied to claim 1 above, Sieling et al. teaches the limitations of the claimed invention however does not teach the housing to contain a rigid synthetic foam of ethylene vinyl acetate. However Manougian et al. teaches a cosmetic container made of foam of ethylene vinyl acetate (Col 17, Lines 2-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Sieling et al. to include the material of Manougian in order for a container having more shock absorption.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Osborne (US Patent # 7,237,971), Ahmed (US Patent #



Art Unit: 4177

6,746,167), Kim (US Patent # 6,715,950), Liu (US Patent # 6,685,373), Young (US Patent # 6,491,464) and Tosto (US Patent # 5,676,480).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIANNE E. O'NEILL whose telephone number is (571)270-7489. The examiner can normally be reached on Monday- Friday, 8:00a.m.- 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272- 4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/  
Primary Examiner, Art Unit 3732  
/B. E. O./  
Examiner, Art Unit 4177